

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nakajima et al.

Serial No.: 10/733,142 *10/733/42*

Filed: 2/9/2004

Title: WEATHER STRIP

Atty. Dkt.: 26GT-004-DIV2

Art Unit: 3634

Examiner: Gregory J. STRIMBU

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

Date: 22 February 2005

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Sir:

In response to the election requirement mailed 26 January 2005 in the above-identified application, Applicants respond as follows.

PROVISIONAL ELECTION

Applicants hereby provisionally elect, with traverse, the Species in Group I (Figs. 1 – 5), with Figs. 23 and 30 being generic to all species. Applicants state that claims 34, 37 and 38 are readable on the Species in Group I.

TRAVERSE

The election requirement is respectfully traversed, because the requirement is improper and does not comply with the criteria for a restriction or an election of species, as specified in 35 USC 121, 37 CFR 1.141-146, and MPEP 801-818.

MPEP 803 specifies that restriction/election between two groups of claims is only proper when (1) the inventions are independent or distinct as claimed and (2) a "serious burden" exists on the examiner in examining the groups of claims. The restriction/election of species requirement does not show either that the groups meet the independent or distinct criteria specified in the MPEP or that there is a "serious burden" in examining the groups of claims in the same application. In fact, it appears that the examiner did not consider the claims currently pending in the application.

The examiner requires restriction and provides reasons therefore, but the reasons are not commensurate with the claims and are not based upon application of the criteria specified in MPEP 806, respecting election of species and restriction requirements. The reasons for request election of species rely upon assertions that are incorrect and analysis that is flawed.

The office action erroneously indicates that claims 1 – 33 are pending. To the contrary, claims 34 – 38 are pending.

The office action states that "no claims are generic." To the contrary, independent claim 34 is generic, and claims 35 – 38 are dependent from claim 34 and include all the limitations of claim 34.

Claim 34 is directed at least in part to the reinforcing portion, illustrated for example in Figs. 1 – 3, 5, 6, 9, 19 and 26 – 29. The reinforcing portion is described as the rib 31 in Figs. 1 –

3, 5, 6, 9 and 29 and as the recovery preventing portion 123 in Figs. 26 – 29. There is no disclosure of the reinforcing portion in the other figures.

The office action identified Groups I – X as the patentably distinct species of the claimed invention. However, the proposed grouping includes figures that are irrelevant to the pending claims.

The following groups of figures are irrelevant to the pending claims because they do not include the claimed reinforcing portion: Fig. 7 (in Group III), Fig. 8 (in Group IV), Figs. 10 – 13 (in Group V), Figs. 14 – 17 (in Group VI), Fig. 18 (in group VII) and Figs. 20 – 22 (in Group VIII). Therefore, the statement in the office action that the application includes claims directed to Groups III – VIII is erroneous.

The applicants propose the following species of the claimed invention, with respect to the pending claims:

Group I Figures 1 – 3, 5, 6, 9 and 19. Claims 34, 37 and 38.

Group II Figures 26 – 29. Claims 34, 35, 36.

For Group I, the reinforcing portion is described as the rib 31. For Group II, the reinforcing portion is described as the recovery preventing portion 123.

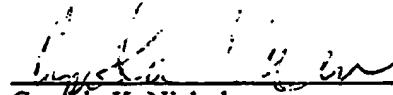
Further, the applicants respectfully indicate that claim 34 is generic.

The applicants respectfully request election the species of Group I, Figs. 1 – 3, 5, 6, 9 and 19.

For the reasons given above, the examiner is respectfully requested to reconsider and withdraw or revise the election of species requirement.

Examination of the present application in view of the above election is respectfully
requested. Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,


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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number: <i>107730-142</i>
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		Art Unit 3634
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ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance communication to (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Posz & Bethards PLC		
Signature	<i>Cynthia K. Nicholson</i>		
Printed name	Cynthia K. Nicholson		
Date	22 February 2005	Reg. No.	36,880

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
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